

Attorney Docket No. 9237.23
Application Serial No.: 10/089,595
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In particular, the Examiner alleges that the claims lack the same or corresponding technical features as set forth under PCT Rule 13.2. To support this position, the Examiner cites Brennan (U.S. Patent No. 5, 474, 796) as allegedly anticipating the set of nucleic acids of claim 38 due to the alleged disclosure in Brennan of the teaching of an array of all possible 10 mer nucleic acids.

The nucleic acids of claim 38 are not anticipated by the teachings of Brennan. Case law very specifically holds and the M.P.E.P. states that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Additionally, anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Apple Computer Inc. v. Articulate Systems Inc.* 57 USPQ2d 1057, 1061 (Fed. Cir. 2000). Brennan, at best, discloses nothing more than an alleged METHOD of producing oligonucleotides that purportedly "represent every possible permutation of the 10-mer oligonucleotide," although the patent provides only prophetic examples and no data and discloses a single 10-mer oligonucleotide, which is not even remotely similar to the nucleic acids of the claimed invention. Claim 38 recites a COMPOSITION of specific sets of nucleic acid segments having specific structural features set forth in the claim, which are not found in Brennan, either expressly or inherently, as required in order for a reference to anticipate. Thus, the requirements for anticipation under 35 U.S.C. § 102(b) are not met by the disclosure of Brennan and claim 38 is not anticipated by this reference. Thus, this reference fails in supporting the position that the pending claims lack the same or a corresponding technical feature.

Furthermore, the method claims of Group 2 all depend from claim 38, either directly or indirectly and therefore the search required for the two groups would indeed be cointensive. As a final point, applicants point out that in the corresponding international application, PCT/US00/28158, no unity of invention issue was raised regarding the subject matter of the pending claims and specifically, the claimed nucleic acid compositions and methods of their use were all included together as Invention 2 in the International Search Report. Thus, applicants respectfully request that